

AUG 14 2006

Application No.: 10/619,619Docket No.: 5000-001**REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Response Under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 1-29 remain pending.

**Claims 1-20 are patentable over Yofu (U.S. Patent 6,408,243)**

The rejection of claims 1-20 under 35 U.S.C. 102(b) as being anticipated by *Yofu* is hereby traversed. A rejection based on 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. Claims 1-20 are patentable over *Yofu* for at least four reasons.

**1. *Yofu* fails to disclose a navigation device for transmitting navigation information to a user device**

First, *Yofu* fails to disclose at least a navigation device adapted for transmitting navigation information to the user device. The PTO asserts that *Yofu* discloses an apparatus for providing information to a user device; however, nowhere does the PTO identify which element of *Yofu* provides navigation information to the user device as claimed in claim 1. The present Official Action (OA) states only that “[t]he navigational device 14 receives information from the input section 22 and information transmission section 23” without identifying any transmission from the navigation device to the user device. OA at page 2, first paragraph. Further, the PTO fails to identify any disclosure in *Yofu* of a transmission of navigation information to the user device from the navigation device as claimed in claim 1. For at least this reason, withdrawal of the rejection is respectfully requested.

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Applicant previously traversed a rejection issued by the PTO based on *Yofu* in response to the OA mailed June 27, 2005 identifying that:

“Specifically, client-side terminal device 11 fails to receive navigation information from navigation apparatus 14. Nor does *Yofu* disclose navigation apparatus 14 transmitting navigation information to client-side terminal device 11. See, e.g., FIG. 2 in which information flows from device 11 to shop side terminal device 13 or navigation apparatus 14 via navigation server apparatus 12 and not from navigation apparatus 14 to device 11.”

Applicant’s response of September 27, 2005 at page 2, fourth paragraph.

Based on the PTO’s issuance of the OA of December 5, 2005 which relies solely on *Sekiyama*, the PTO is believed to have accepted Applicant’s arguments and the reference has been overcome and rejections based thereon should be withdrawn. For at least this further reason, withdrawal of the rejection is respectfully requested.

**2. *Yofu* fails to disclose at least wherein the user device is removable and transportable from the vehicle**

Second, *Yofu* fails to disclose at least wherein the user device is removable and transportable from the vehicle. The present OA is silent regarding any teaching or suggestion in *Yofu* of the user device being removable and/or transportable from a vehicle. Additionally, *Yofu* fails to disclose user device 11 as being installable in a vehicle. *Yofu* appears to describe the user device 11 as being a user terminal, and more specifically, being a computer system. See for example, FIG. 2, element 11. For at least this reason, withdrawal of the rejection is respectfully requested.

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Third, *Yofu* fails to disclose at least a navigation device arranged to perform map matching. Map matching comprises correlating a vehicle position with a nearest road on a map. *Yofu* appears to describe position information comprising solely latitude and longitude information and fails to describe correlating such a position with a road on a map. For at least this reason, withdrawal of the rejection is respectfully requested.

4. A §102 rejection requires application of a single reference

Fourth, the PTO appears to be relying on a secondary reference, i.e., *Sekiyama*, for asserting disclosure of map matching; however, a rejection based on 35 U.S.C. 102 requires every element of the claim to be included in a single reference. As the present rejection appears to rely on *Sekiyama* in addition to *Yofu*, withdrawal of the rejection is respectfully requested.

If instead of a §102 rejection, the PTO is asserting rejection of the claims under 35 U.S.C. 103, then PTO has failed to set forth a prima facie case of obviousness. The PTO has failed to identify any motivation or suggestion in either reference teaching, suggesting, or describing the potentially asserted combination.

In accordance with MPEP §2143.01 and *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the PTO is requested to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the personal knowledge of the PTO per MPEP §2144.03 providing a motivation or suggestion to one of ordinary skill in the art to make the argued combination. The PTO has neither identified any teaching in *Yofu* or *Sekiyama* motivating or suggesting the asserted combination to a person of ordinary skill in the

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art nor provided an affidavit because there is no teaching to be found. For at least this reason, the rejection should be withdrawn.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The PTO has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The PTO is in error for any of the above reasons and has not made out a *prima facie* case of obviousness, and the rejection of claim 1 should be withdrawn.

For each of the foregoing reasons, claim 1 is patentable over *Yofu* singly or in combination with *Sekiyama* and the rejection should be withdrawn.

Claims 2-8, 21, 22, and 25-27 depend, either directly or indirectly, from claim 1, include further important limitations, and are patentable over *Yofu* for at least the reasons advanced above with respect to claim 1. For at least this reason, the rejection of claims 2-8, 21, 22, and 25-27 should be withdrawn.

Claim 9 is patentable over *Yofu* for at least reasons similar to those advanced above with respect to claim 1 and the rejection should be withdrawn.

Claims 10-16, 23, 24, and 28 depend, either directly or indirectly, from claim 9, include further important limitations, and are patentable over *Yofu* for at least the reasons advanced above with respect to claim 9. The rejection of claims 10-16, 23, 24, and 28 should be withdrawn.

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Claim 17 is patentable over *Yofu* for at least reasons similar to those advanced above with respect to claim 1 and the rejection should be withdrawn.

Claims 18-20 and 29 depend, either directly or indirectly, from claim 17, include further important limitations, and are patentable over *Yofu* for at least the reasons advanced above with respect to claim 17. The rejection of claims 18-20 and 29 should be withdrawn.

**Remainder of the OA**

Applicant traverses the remainder of the present OA as being unfounded. First, as stated above, the PTO refers to a second reference, i.e., *Sekiyama*, in several portions of the OA; however, an anticipation rejection cannot be based on the combination of two or more references.

Second, *Sekiyama* fails to disclose a navigation device which is arranged to perform map matching as pointed out in Applicants' immediately prior response of March 2, 2006.

Third, Applicants' specification describes "two main types of vehicle navigation systems currently in use" without specifying that there are only two types of navigation systems. The PTO appears to be engaging in speculation where none is required as *Sekiyama* appears to describe a contents integration engine 101 for integrating map data or route data to a destination, each of which is resident and operating on an information center which includes "a plurality of servers and databases." *Sekiyama* at column 5, lines 15-20. *Sekiyama* describes navigation functionality performed at a server remote from the on-vehicle information processing device 10. For at least this reason, claims 1-29 remain patentable over *Sekiyama*.

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Fourth, the PTO recites that “[c]laims 1-8, 9-16, and 17-24 each recite similar patentable limitations.” Present OA at page 3, line 5.

Fifth, the PTO asserts that claims 25-29 recite no new limitations “that cannot be construed from the abstract of *Sekiyama*; however, *Sekiyama* has not been applied by the PTO in rejecting the claims. The PTO has failed to identify where in the abstract of *Sekiyama* there is a teaching of at least the navigation device being arranged to perform routing responsive to commands received from the user device. As described above, *Sekiyama* appears to describe the navigation functionality as being performed at a server remote from the on-vehicle information processing device 10. Further, the PTO has failed to identify where in *Yofu* the limitations of claims 25-29 are found. For at least this reason, claims 25-29 remain patentable over *Yofu* and *Sekiyama* and rejections based thereon should be withdrawn.

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All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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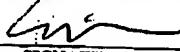


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